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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,094	12/05/2003	Young-Ho Hahn	25866	7288

20529 7590 02/17/2006

NATH & ASSOCIATES
112 South West Street
Alexandria, VA 22314

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,094

Applicant(s)

HAHN ET AL.

Examiner

JOHN PAK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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Claims 1-4 are pending in this application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

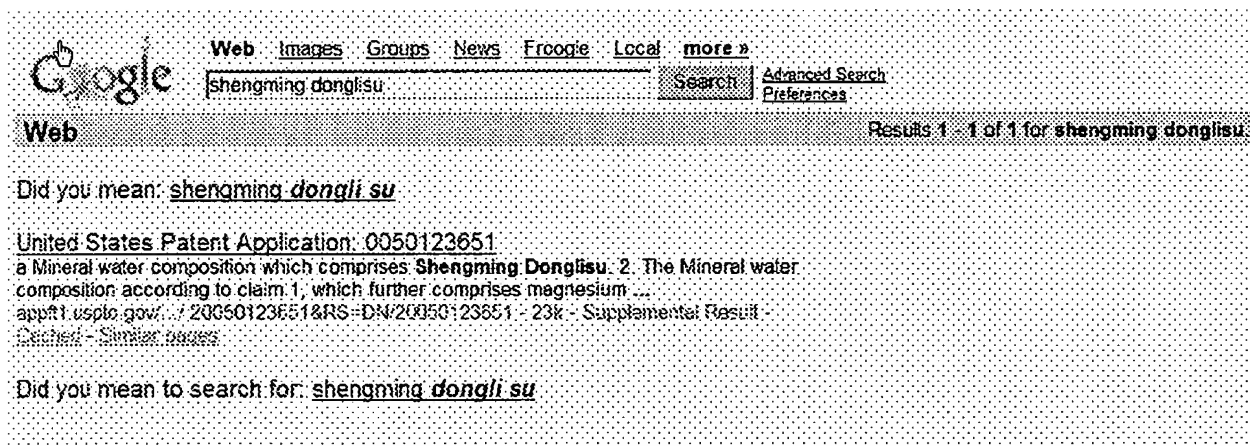
The instant invention requires "Shengming Donglisu." Based on the evidence of record at this time, it is the Examiner's position that one skilled in the art would not be able to determine what "Shengming Donglisu" is and therefore would not be able to obtain the composition claimed by applicant.

Despite a broad search in GOOGLE, the U.S. Patents and Patent Application Publication database, Japanese Patent database, Derwent database, Chemical Abstracts (HCAPLUS), Medline, Biosis, CAB Abstracts, Life Sciences Collection (LIFESCI), Natural Products Alert (NAPRALERT), Health and Safety Science Abstract (HEALSAFE), and Korean Patent Abstracts, no other use of the term "Shengming Donglisu" can be found except by applicant in the publication of this application (US 2005/0123651). Clearly, the state of the art fails to teach one skilled in the art how to

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obtain the substance, and neither does applicant in the instant specification. See the search results documented below.

GOOGLE Search



The screenshot shows a Google search interface. At the top, there are links for Web, Images, Groups, News, Froogle, Local, and more. The search bar contains the text 'shengming donglisu'. To the right of the search bar are links for Search, Advanced Search, and Preferences. Below the search bar, it says 'Web' and 'Results 1 - 1 of 1 for shengming donglisu'. The search result is for a United States Patent Application: 0050123651. The title is 'a Mineral water composition which comprises Shengming Donglisu. 2. The Mineral water composition according to claim 1, which further comprises magnesium ...'. The URL is 'appft1.uspto.gov/.../20050123651&RS=DN/20050123651-23&-Supplemental+Result'. Below the URL, it says 'Cached - Similar pages'. At the bottom, it says 'Did you mean to search for: shengming dongli su'.

USPTO Databases + JPAB + Derwent

DATE: Thursday, February 16, 2006 [Printable Copy](#) [Create Case](#)

<u>Set Name</u>	<u>Query</u>	<u>Hit Count</u>	<u>Set Name</u>
side by side			result set
	DB=PGPB,USPT,JPAB,DWPI; THES=ASSIGNEE; PLUR=YES; OP=ADJ		
<u>L1</u>	shengming donglisu or shengming dongli su	1	<u>L1</u>

END OF SEARCH HISTORY

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**STN Online Databases HCAPLUS, MEDLINE, BIOSIS,
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L1      0 SHENGMING DONGLI? OR SENGMING DONGLI?
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Based on the above discussed nature of the claimed invention, the state of the prior art, and the several factors to be discussed hereinbelow, one skilled in the art would not be able to determine what is or is not Shengming Donglisu, and he/she would not be able to make the composition as claimed without undue experimentation. Even though the relative skill of those in the art is high, unpredictability in this field is also

quite high because it is not known exactly what is or is not in Shengming Donglisu. Applicant provides no guidance in the specification as to the exact makeup of Shengming Donglisu and no guidance as to how one skilled in the art can obtain Shengming Donglisu with accuracy. Although specification page 4, lines 18-22 discloses that "Sengmin Donglisu" (not spelling inconsistency) is a mixture of minerals which are extracted from natural ores such as celestine, paigeite, vermiculite, limestone, mica, colorata and elvan, there is no teaching or guidance as to how exactly "Sengmin Donglisu" is to be extracted from these minerals. Different methods of extraction would yield different compositions. Different temperature, different solvent, different techniques would all produce different compositions. Example: simple immersion in cold water of one mineral; simple immersion in hot water of five minerals; acid extraction of three minerals; base extraction of two minerals; Pressurized extraction using oily solvents; etc. Presence or absence of working example is of little use here since the issue is what's in Shengming Donglisu and/or how one skilled in the art can accurately obtain Shengming Donglisu. The claimed invention therefore fails to find adequate enabling support from the disclosure because not knowing these facts would lead one skilled in the art to resort to undue experimentation in order to arrive at the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The basis for this ground of rejection is that one skilled in the art would not understand what "Shengming Donglisu" is. The search results evidenced in the preceding pages show that the term used by applicant is not typically found in scientific publications. Therefore, without more, the required use of Shengming Donglisu constitutes indefinite claim language.

All claims are thereby rejected. No claim is allowed.

Applicant is advised that the Reference AL on applicant's PTO-1449 was crossed out because it was submitted without a concise explanation of its relevance or an English translation.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK
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